

## UNITED STATES DEF TMENT OF COMMERCE Patent and Trad mark \_flic Address: COMMISSIONER OF PATENTS AND TRADEMARKS Washington, D.C. 20231



APPLICATION NUMBER	FILING DATE			_
08/441,44	10 05	FIRST NAMED APPLICANT		ATTY DOCKET NO.
	00/10/95	HOUGHTON	М	
			m	0063.024
ALTON		UMDO to e		EXAMINER
ALISA A H CHIRON COL	ARBIN	HM22/0519		
INTELL FOT	HOLDRATION		75MA	No M
P 0 B0X 8	UAL PROPERTY - R	440	ANTO	PAPER NUMBER
EMERYVILLE	E CA 94662-8097			17
	- 511 54662-8097		1643	
			DATE MAILE	D:
				05/19/99
This is a communication from	the examiner in charge of your			
COMMISSIONER OF PATEN	ITS AND TRADEMARKS	supplication.		
	OFFIC	E ACTION SUMMARY		
Responsive to communical	31.1100	1		
	tion(s) filed on 711	1		
This action is FINAL.				
Since this positions				
accordance with the practic	condition for allowance excep	it for formal matters, prosecution a 35 D.C. 11; 453 O.G. 213.		
	condition for allowance except te under <i>Ex parte Quayle</i> , 19.	35 D.C. 11; 453 O.G. 213.	s to the merits	is closed in
the application to be the	illing date of this communicat	ion Failure 4	month(s), or	thirty days
1.136(a).	loned. (35 U.S.C. § 133). E:	t to expire	eriod for respons	se will cause
		ion. Failure to respond within the p densions of time may be obtained u	naer the provision	ons of 37 CFR
Disposition of Claims				
A Claim(s) 40 - 59				
Of the above, claim(s)	0 =			
Claim(s)	7-51		is/are pendi	ng in the application.
	07 -60		is/are withdrawn	from consideration.
	36.59			is/are allowed.
K Claim(a) W( 11 & a				
△ Claim(s) 46-48 + 92	2-95			is/are rejected.
□ Claim(s) 46 - 48 + 9a     □ Claim(s)	2-95	are subject	ie/	is/are rejected.
△ Claim(s) 46-48 + 92	2-95	_are subject	ie/	is/are rejected.
☑ Claim(s) 46-48+ 9a ☐ Claim(s)  Application Papers	2-95		ie/	is/are rejected.
Claim(s) 46 - 48 + 9c     Claim(s)  Application Papers  ☐ See the attached Notice of Drawning Control of Drawning Contro	2-95		ie/	is/are rejected.
Claim(s) 46-48 + 92  Claim(s)  Application Papers  See the attached Notice of Dra  The drawing(s) filed on	255 aftsperson's Patent Drawing	Review, PTO-948,	is/a to restriction or e	is/are rejected.
Claim(s) 46-48+95 Claim(s) Application Papers See the attached Notice of Dra The drawing(s) filed on The proposed trawing consult	aftsperson's Patent Drawing	Review, PTO-948, is/are objected to by the	is/ito restriction or e	is/are rejected. are objected to. election requirement.
Claim(s) 46-48+92  Claim(s)  Application Papers  See the attached Notice of Dra  The drawing(s) filed on  The proposed drawing corrects  The specification is belonged to	2-65 aftsperson's Patent Drawing	Review, PTO-948, is/are objected to by the	is/ito restriction or e	is/are rejected. are objected to. election requirement.
Claim(s) 46 - 48 + 92     Claim(s)     Claim(s)     Application Papers     See the attached Notice of Drr.     The drawing(s) filled on	2-65 aftsperson's Patent Drawing	Review, PTO-948, is/are objected to by the	is/ito restriction or e	is/are rejected.
Scalm(s) 46-48-92  Claim(s)  Application Papers  See the attached Notice of Drr.  The drawing(s) filled on  The proposed drawing correct  The specification is objected to  The oath or declaration is object.	2-65 aftsperson's Patent Drawing	Review, PTO-948, is/are objected to by the	is/ito restriction or e	is/are rejected. are objected to. election requirement.
S Claim(s) 46 4 52  Claim(s)  Application Papers  See the attached Notice of Drz  The drawing(s) filled on  The proposed drawing corrects  The specification is object on  The cath or declaration is object  Priority under 35 U.S.C. § 119	affsperson's Patent Drawing  on, filed on  by the Examiner,  sted to by the Examiner.	Review, PTO-948, is/are objected to by the state of the s	is/ito restriction or e	is/are rejected. are objected to. election requirement.
Claim(s) 46 - 4 8 4 92  Claim(s)  Application Papers  See the attached Notice of Drz  The drawing(s) filled on  The proposed drawing corrects  The specification is object  The oath or dectaration is object  Priority under 35 U.S.C. § 119  Acknowledgment is made of a c	affsperson's Patent Drawing on, filed on by the Examiner, cted to by the Examiner.	Review, PTO-948.  Jis/are objected to by the state of the	is/ito restriction or e	is/are rejected. are objected to. election requirement.
Claim(s) 46 - 4 8 4 92  Claim(s)  Application Papers  See the attached Notice of Drz  The drawing(s) filled on  The proposed drawing corrects  The specification is object  The oath or dectaration is object  Priority under 35 U.S.C. § 119  Acknowledgment is made of a c	affsperson's Patent Drawing on, filed on by the Examiner, cted to by the Examiner.	Review, PTO-948.  Jis/are objected to by the state of the	is/ito restriction or e	is/are rejected. are objected to. election requirement.
Claim(s) 46 - 48 + 92  Claim(s)  Application Papers  See the attached Notice of Drr  The proposed drawing correct  The proposed drawing correct  The papicitation is objected to  The oath or declaration is object  Priority under 35 U.S.C. § 119  Acknowledgment is made of a c	affsperson's Patent Drawing on, filed on by the Examiner, cted to by the Examiner.	Review, PTO-948.  Jis/are objected to by the state of the	is/ito restriction or e	is/are rejected. are objected to. election requirement.
SC Claim(s) 46 - 48 + 92 Claim(s) Application Papers    See the attached Notice of Dre   The drawing(s) filled on   The proposed drawing corrects   The specification is objected to   The oath or declaration is object   Priority under 35 U.S.C. § 119   Acknowledgment is made of a c   Acknowledgment is made of a c   received.	affsperson's Patent Drawing ion, filed on	Review, PTC-948,  Is/aire objected to by the second of the second	is/ito restriction or e	is/are rejected. are objected to. election requirement.
Claim(s) 46 - 48 + 92  Claim(s)  Application Papers  See the attached Notice of Drawing Correct  The drawing(s) filled on  The proposed drawing correct  The specification is objected to  The oath or declaration is object  Acknowledgment is made of a co  All Some* None  received in Application No.	aftsperson's Patent Drawing i on, filed on by the Examiner. cted to by the Examiner. claim for foreign priority unde of the CERTIFIED copies o	Review, PTC-948,is/are objected to by the second of	is/ito restriction or e	is/are rejected. are objected to. election requirement.
Claim(s) 46 - 48 + 92  Claim(s)  Application Papers  See the attached Notice of Drawing Correct  The drawing(s) filled on  The proposed drawing correct  The specification is objected to  The oath or declaration is object  Acknowledgment is made of a co  All Some* None  received in Application No.	aftsperson's Patent Drawing i on, filed on by the Examiner. cted to by the Examiner. claim for foreign priority unde of the CERTIFIED copies o	Review, PTC-948,is/are objected to by the second of	is/ito restriction or e	is/are rejected. are objected to. election requirement.
So Claim(s) 46 - 48 + 92 Claim(s) Claim(s) Application Papers  See the attached Notice of Driver Control of the drawing correction The proposed drawing correction The specification is objected to The specification is objected to The oath or declaration is object Acknowledgment is made of a company of the control of the	aftsperson's Patent Drawing i on, filed on by the Examiner. cted to by the Examiner. claim for foreign priority unde of the CERTIFIED copies o	Review, PTC-948,is/are objected to by the second of	is/ito restriction or e	is/are rejected. are objected to. election requirement.
S. Claim(s) 46-48-92  Claim(s)  Application Papers  See the attached Notice of Dr.  The proposed drawing correct  The specification is objected to  The oath or declaration is object  Acknowledgment is made of a c  All Some* None  received in Application No. (  received in this national stag  "Certified copies not received:	aftsperson's Patent Drawing in on, filed on filed con. filed to by the Examiner. It is to by the Examiner. It is the Examiner of the CERTIFIED copies	Review, PTC-948,is/are objected to by tillsis	is/ito restriction or e	is/are rejected. are objected to. election requirement.
S. Claim(s) 46-48-92  Claim(s)  Application Papers  See the attached Notice of Dr.  The proposed drawing correct  The specification is objected to  The oath or declaration is object  Acknowledgment is made of a c  All Some* None  received in Application No. (  received in this national stag  "Certified copies not received:	aftsperson's Patent Drawing in on, filed on filed con. filed to by the Examiner. It is to by the Examiner. It is the Examiner of the CERTIFIED copies	Review, PTC-948,is/are objected to by tillsis	is/ito restriction or e	is/are rejected. are objected to. election requirement.
S. Claim(s) 46-48-92  Claim(s) 46-48-92  Claim(s) 46-48-92  Application Papers  See the attached Notice of Dri The drawing(s) filled on The proposed drawing correctly The specification is objected to The about or declaration is object The about or declaration is object Acknowledgment is made of a claim Teccived in Application No. ( Teccived in Application No. ( Teccived in this national stage  "Certified copies not received:  Acknowledgment is made of a cla	aftsperson's Patent Drawing in on, filed on filed con. filed to by the Examiner. It is to by the Examiner. It is the Examiner of the CERTIFIED copies	Review, PTC-948,is/are objected to by tillsis	is/ito restriction or e	is/are rejected. are objected to. election requirement.
So Claim(s) 46 - 48 + 92 Claim(s) Claim(s) Application Papers  See the attached Notice of Driver Control of the drawing correction The proposed drawing correction The specification is objected to The specification is objected to The oath or declaration is object Acknowledgment is made of a company of the control of the	aftsperson's Patent Drawing in on, filed on filed con. filed to by the Examiner. It is to by the Examiner. It is the Examiner of the CERTIFIED copies	Review, PTC-948,is/are objected to by tillsis	is/ito restriction or e	is/are rejected. are objected to. election requirement.
Claim(s) 46 - 48 + 92  Claim(s)  Application Papers  See the attached Notice of Dri The drawing(s) filed on The proposed drawing correctly The specification is objected to The specification is objected to The about or declaration is object Acknowledgment is made of a ce  Acknowledgment is made of a ce  "cerelived in Application No. ( received in Application No. ( Acknowledgment is made of a claim Attachment(s)	aftsperson's Patent Drawing in on, filed on the comment of the Examiner. It is the Examiner of the Examiner of the CERTIFIED copies of the CERTIFIED c	Review, PTC-948,is/are objected to by tillsis	is/ito restriction or e	is/are rejected. are objected to. election requirement.
Claim(s)	affsperson's Patent Drawing on, filed on	Review, PTC-948, is/are objected to by the is/are objected to the is/are objected to by the is/are objected to by the is/are objected to by the is/are objected to be is/are objected to be included in the priority documents have been attional Bureau (PCT Rule 17.2(a)).	is/ito restriction or e	is/are rejected. are objected to. election requirement.
Claim(s) 46 - 48 + 92     Claim(s) 46 - 48 + 92     Claim(s) Application Papers   See the attached Notice of Dre   The drawing(s) filed on     The proposed drawing corrects     The specification is objected to     The specification is objected to     The cath or declaration is objected to     The cath or declaration is objected to     Acknowledgment is made of a claim of the cath of th	affsperson's Patent Drawing on, filed on	Review, PTC-948, is/are objected to by the is/are objected to the is/are objected to by the is/are objected to by the is/are objected to by the is/are objected to be is/are objected to be included in the priority documents have been attional Bureau (PCT Rule 17.2(a)).	is/ito restriction or e	is/are rejected. are objected to. election requirement.
Claim(s) 46 - 48 + 92     Claim(s) 46 - 48 + 92     Claim(s) Application Papers   See the attached Notice of Dre   The drawing(s) filed on     The proposed drawing corrects     The specification is objected to     The specification is objected to     The cath or declaration is objected to     The cath or declaration is objected to     Acknowledgment is made of a claim of the cath of th	affsperson's Patent Drawing on, filed on	Review, PTC-948, is/are objected to by the is/are objected to the is/are objected to by the is/are objected to by the is/are objected to by the is/are objected to be is/are objected to be included in the priority documents have been attional Bureau (PCT Rule 17.2(a)).	is/ito restriction or e	is/are rejected. are objected to. election requirement.
Claim(s) 46 - 48 + 92     Claim(s) 46 - 48 + 92     Claim(s)     Application Papers     See the attached Notice of Dri     The proposed drawing correct     The proposed drawing correct     The specification is objected to     The oath or declaration is object     The oath or declaration is object     Acknowledgment is made of a claim of the control of the contro	aftsperson's Patent Drawing on, filed on by the Examiner. cted to by the Examiner. claim for foreign priority unde of the CERTIFIED copies o general Number) pa application from the Intern aim for domestic priority unde	Review, PTC-948, is/are objected to by the is/are objected to the is/are objected to by the is/are objected to by the is/are objected to by the is/are objected to be is/are objected to be included in the priority documents have been attional Bureau (PCT Rule 17.2(a)).	is/ito restriction or e	is/are rejected. are objected to. election requirement.
Claim(s) 46 - 48 + 92  Claim(s) - 46 - 48 + 92  Claim(s) - 46 - 48 + 92  Application Papers  See the attached Notice of Drift The drawing(s) filled on - 48  The proposed drawing correctly only on the proposed drawing correctly on the proposed drawing correctly on the proposed drawing correctly on the proposed drawing company on the proposed of a claim of the proposed of the propo	aftsperson's Patent Drawing in on, filed on by the Examiner. It is a first for foreign priority under of the CERTIFIED copies	Review, PTC-948, is/are objected to by the is/are objected to the is/are objected to by the is/are objected to by the is/are objected to by the is/are objected to be is/are objected to be included in the priority documents have been attional Bureau (PCT Rule 17.2(a)).	is/ito restriction or e	is/are rejected. are objected to. election requirement.
Claim(s) 46 - 48 + 92  Claim(s) - 46 - 48 + 92  Claim(s) - 46 - 48 + 92  Application Papers  See the attached Notice of Drift The drawing(s) filled on - 48  The proposed drawing correctly only on the proposed drawing correctly on the proposed drawing correctly on the proposed drawing correctly on the proposed drawing company on the proposed of a claim of the proposed of the propo	aftsperson's Patent Drawing in on, filed on by the Examiner. It is a first for foreign priority under of the CERTIFIED copies	Review, PTC-948, is/are objected to by the is/are objected to the is/are objected to by the is/are objected to by the is/are objected to by the is/are objected to be is/are objected to be included in the priority documents have been attional Bureau (PCT Rule 17.2(a)).	is/ito restriction or e	is/are rejected. are objected to. election requirement.
Claim(s) 4/6 - 4/8 + 9/2     Claim(s) 4/6 - 4/8 + 9/2     Claim(s)     Application Papers     See the attached Notice of Drist	aftsperson's Patent Drawing aftsperson's Patent Drawing ion, filed on by the Examiner. It alm for foreign priority under of the CERTIFIED copies of th	Review, PTC-948, is/are objected to by the service objected to by the service of the priority documents have been stional Bureau (PCT Rule 17.2(a)).	is/ito restriction or e	is/are rejected. are objected to. election requirement.
Claim(s) 4/6 - 4/8 + 9/2  Claim(s) - 4/6 - 4/8 + 9/2  Claim(s)	aftsperson's Patent Drawing aftsperson's Patent Drawing ion, filed on by the Examiner. It alm for foreign priority under of the CERTIFIED copies of th	Review, PTC-948, is/are objected to by the is/are objected to the is/are objected to by the is/are objected to by the is/are objected to by the is/are objected to be is/are objected to be included in the priority documents have been attional Bureau (PCT Rule 17.2(a)).	is/ito restriction or e	is/are rejected. are objected to. election requirement.

Application/Control Number: 08/441,443

Art Unit: 1643

## DETAILED ACTION

- Claims 40-48 and 52-59 are pending in this application. Claims 49-51 have been withdrawn from consideration as being drawn to a non-elected invention, and must be@anceled in response to this action. Claims 56-59 are newly added.
- Applicant's arguments filed 3/4/99 have been fully considered but they are not completely
  persuasive.
- The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

In view of Applicant's amendments or arguments the following objections or rejections are withdrawn:

The rejection of claims 40-48 and 52-55 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention for the reasons set forth in the previous office action is withdrawn.

## **Double Patenting**

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686

Application/Control Number: 08/441,443

Art Unit: 1643

F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 40-45 and new claims 56-59 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 5,714,596. Although the conflicting claims are not identical, they are not patentably distinct from each other because the oligonucleotides of the '596 patent fulfill the limits of claims 40-45, as an oligonucleotide can be used as an antisense nucleotide, and an antisense polynucleotide can be use as an oligonucleotide. The chemical compositions are the same, and the recitation of "antisense" is merely a statement of intended use. Likewise, the recitation of "pharmaceutical composition" and "pharmaceutically acceptable excipient" do not distinguish over the claims of the patent, as the pharmaceutically acceptable excipient could be water, saline or other liquid in which one would find the "purified preparation of an oligonucleotide" as in the '596 patent.

## Conclusion

No claim is allowed.

Art Unit: 1643

- 7. Claims 46-48 and 52-56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

  8. THIS ACCION 163-178.
- THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary K Zeman whose telephone number is (703) 305-7133. The examiner can be reached between the hours of 7:30 am and 5:00 pm Monday through Thursday, and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Eisenschenk, can be reached on (703) 308-0452.

The fax number for this Art Unit is (703) 305-7401.

Art Unit: 1643

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

mkz

May 17, 1999

Frank C. Eisenschenk

Supervisory Patent Examiner, Group 1600